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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,623	10/06/2001	Robert H. Cheyne III	0499-021B	5190

7590

04/23/2004

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Suite 5A  
Hoboken, NJ 07030

EXAMINER
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ROSE, ROBERT A

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 04/23/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/972,623

Applicant(s)

CHEYNE, ROBERT H.

Examiner

Robert Rose

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Receipt is acknowledged of Applicant's Amendment, filed October 14, 2003.
2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-18 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9, and 12-19 of prior U.S. Patent No. 6,299,520. Claims 1-18 are deemed to be fully met by the claims of Applicant's U.S. Patent No. 6,299,520. This is a double patenting rejection.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cueman et al. Cueman et al disclose a non-absorbent antimicrobial surface comprising all of the subject matter set forth in Applicant's claims above. An antimicrobial agent is incorporated into a polymeric resin binder coating which is then cured on the substrate surface.
6. Claims 1-4, 10-12, and 19-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hyman et al. Hyman et al disclose a non-absorbent antimicrobial surface

comprising all of the subject matter set forth in Applicant's claims above. An antimicrobial agent is incorporated into a polymeric resin binder coating which is then cured on the substrate surface.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-7, 14-15, 21, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Cueman et al or Hyman et al in view of Mori. Mori discloses a non-absorbent antimicrobial surface comprising an antimicrobial agent incorporated into a cured polymeric resin binder coating, which may be adhered to a substrate. Mori specifically discloses an antibacterial additive comprising the compound diiodomethyl-p-tolysulfone. To incorporate such a known antimicrobial compound into the resins of either Cueman et al or Hyman et al to cover a wider range of microbes would have been obvious in view of Mori.

9. Claims 8-9, 16-18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyman et al in view of Mori and further in view of Cameron. Hyman et al teach at column 11, lines 60-64 that combinations of antibacterial agents may be combined to cover a broader spectrum of organisms. Mori discloses an antibacterial polymeric binder comprising the compound diiodomethyl-p-tolysulfone. To incorporate a known antibacterial agent such as a sulfone into the resin binder of Hyman et al prior to curing to prevent the formation of bacteria or

mildew in the pad during prolonged periods of non-use, within the spectrum covered by the sulfone compound, would have been obvious in view of Mori. Cameron discloses the known use of lauryl sulfate in a detergent pad formed of non-woven nylon fibers(column 5, line 18). To further incorporate a second known antibacterial agent such as lauryl sulfate into the binder of Hyman et al to prevent formation of bacteria during prolonged periods of non-use would have been obvious in view of Cameron. Such use of plural agents would protect the ultimate user from a wider variety of bacteria which could otherwise grow in the pad during periods of non-use.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosenblatt, and Larson et al are cited of interest to show sponges comprising a polymer containing antimicrobial substances.

11. Applicant's arguments filed October 14, 2003 have been considered but they are not persuasive. Claims 1-9, and 12-19 of Applicant's U.S. Patent No. 6,299,520 fully anticipate the subject matter of claims 1-18. With regard to the new limitation in claim 1, requiring that the antimicrobial agent be cured with the polymeric coating, is deemed to be met by the disclosures of both Cueman et al and Hyman et al, each of which disclose cured polymeric coatings having antibacterial agents.

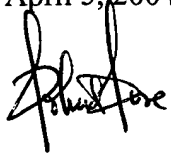
12. In view of the new grounds of rejection not necessitated by Applicant's response, this action is not made final.

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13. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (703) 308-1360.

Rr

April 5, 2004.

A handwritten signature in black ink, appearing to read "Robert A. Rose", written over the typed name.

ROBERT A. ROSE  
PRIMARY EXAMINER  
ART UNIT 323